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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,853	10/08/2004	Timothy Dawson	60036.0001US01	5852

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HOPE BALDAUFF HARTMAN, LLC
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SUITE 1010
ATLANTA, GA 30309

EXAMINER

FARAH, AHMED M

ART UNIT	PAPER NUMBER
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3735

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/711,853	Applicant(s) DAWSON, TIMOTHY	
	Examiner Ahmed M. Farah	Art Unit 3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 3 and 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckhardt et al. Pub. No. US 2003/0031586 in view of Tanner et al. US Patent No. 5,125,923.

As to claims 3 and 10, Eckhardt et al. disclose a hand-held UV device and method of use for sterilizing or disinfecting a region of tissue **5** including a skin and tissue below the skin (see Fig. 1), the apparatus comprising:

a UV light source **7a**;

a protective cover made from quartz, fused silica, or an UV transmissive glass or screen that fits over the light source (see paragraphs [0038]);

a power source **33** for supplying power to the light source (see Fig. 4A); and

a case **17** that contains the power source and connects to the UV transmissive protective cover (see Figures 3, 4A-E, and 5A-C).

As to claim 5, Eckhardt et al. teach that "the timing for each operation may be preformed by a standard timer or with a light sensor that measures light exposure and turns continuous light source **7b** off when a desired dosage is reached. Continuous

process sterilization/disinfection unit 16b may also be turned on and off manually by an operator.” See paragraph [0057].

As to 6, in one embodiment of the invention, the power source includes a battery **33** power supply (see Fig. 4A).

As to claim 7, Eckhardt et al. further teach the derive circuit of their invention is the same as that used for fluorescent lamps as follows:

“The drive circuitry for continuous light source 7b of continuous process sterilization/disinfection unit 16b is included in housing 17. The circuitry is not shown here, as it is typically the same as that used for standard visible fluorescent lamps and is well known to those skilled in the art.”

See paragraph [0060]. It is known in the art that ballasts are used to provide the starting voltage or to stabilize the current in a circuit of a fluorescent lamp. Hence, Eckhardt et al. anticipate the claim.

As to claim 8, the device further comprises a reflective cover **9** to direct the UV light.

Eckhardt et al. further teach the use of a power switch **23**, a safety interlock, and a trigger switch **27** to enhance safety of the sterilization/disinfection device (see paragraphs [0042], [0044], and [0045]). They teach the “safety interlock actuators **21** detect the compression of one or more locations (e.g., six as shown in FIG. 4C) to verify that light seal **19** is placed against a surface before flash light source 7a is allowed to trigger.” They further teach that the:

“Instantaneous sterilization/disinfection device 16a [shown in Fig. 12] includes a circuit board enclosed within the house 17. Circuit board 29 may include a capacitor 31 for storing a charge used by flash light source 7a to generate a flash, and circuitry to charge the capacitor and control

the charging and flashing. Circuit board 29 is also coupled to a power source and safety interlock circuitry to prevent accidental triggering at inappropriate times.”

See paragraph [0044].

Nevertheless, although they teach the safety interlock /switch mechanism includes skin/tissue sensors, they do not particular teach that the safety mechanism is configured for sensing hand of the operator as claimed. Tanner et al. teach an alternative handheld treatment apparatus comprising a light source and a safety switching assembly incorporated in the handle portion of the apparatus to sense proper grip of an operator's hand in order to initiate firing of the light source (see col. 2, lines 3-24). Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify Eckhardt et al. in view of Tanner et al. and incorporate to the handle portion of the device a switching mechanism that senses proper handgrip of the operator in order to initiate firing of the treatment light source. This would have been an obvious improvement safety mechanism.

2. Claims 1, 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cumbie US Patent No. 6,960,201 in view of Tanner et al., described above.

Cumbie discloses a method and apparatus for treating nail infection, such as onychomycosis (see col. 8, lines 6-8), comprising: directing a UV light source **10** at the area of the body **16** to be treated; and irradiating the area with a UV light in the wavelength range of 254 nm for a predetermined time (see Fig. 1; col. 7, lines 8-15; and col. 8, lines 58-60).

As to the recitation the "sensing that the device is held by a hand" in claim 1, the operator/surgeon would physically and visually sense/feel holding the device.

Claim 1 further recites the step of directing the treatment UV light through "UV transmissive cover." Nevertheless, the applicant does not teach that said cover alters the method step in a manipulative sense.

Combie does not teach the light source includes an UV transmissive cover in which the treatment energy is directed there through. However, his device includes open window in which the treatment UV light directed to the tissue passes through and a light opaque mask **18** comprising open regions 24 configured to pass the UV light to selected tissue while masking the surrounding tissues.

Tanner et al. teach an alternative tissue treatment apparatus and method of use, the method comprising the step of directing UV light source and an associated UV transmissive cover to the treatment site, such that the treatment light reaches the desired region unaltered.

Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to incorporate UV transmissive cover into the device. This cover would protect the light source from mechanical damage without altering/filtering the treatment light. Moreover, the court decided "to be entitled to weight ... structural limitations must affect method in a manipulative sense and not amount to mere claiming of use of a particular structure. See *Exparte Pfeiffer* 782 O.G. 639, 1962 CD 408 (also, see 135 USPQ 31).

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the following references:

Eckhardt et al. US Patent No. 6,730,223, see Figs. 3-5C.

Hartman US Patent No. 6,447,537, see Figs. 5 and 7A-E.

Frankena US Patent No. 4,950,903, see Fig. 3.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ahmed M. Farah whose telephone number is (571) 272-

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4765. The examiner can normally be reached on Mon, Tue, Thur and Fri between 9:30 AM 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marmor II Charles can be reached on (571) 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ahmed M Farah/
Primary Examiner, Art Unit 3735

July 31, 2008.